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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,289	04/28/1999	MASATOSHI MOTEKI	551512/058	9554

7590

11/20/2002

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EXAMINER

GOODWIN, JEANNE M

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/297,289

Applicant(s)

MOTEKI ET AL.

Examiner

Jeanne-Marguerite Goodwin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-40 and 54-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-40 and 54-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In this case, said spring lying in a plane as claimed in claims 14, 23, 34 and 54.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 14-40 and 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,517,469 to Wiget [hereinafter Wiget] in view of JP Abstract 57108237 to Tadashi [hereinafter Tadashi].

Wiget discloses a timepiece using a spring 2, said spring being formed of a spirally arranged metal and lying in a plane and serving as a source of power. Wiget discloses all the subject matter claimed by applicant with the exception of the limitation stated in claims 14, 23 and 34, i.e., the spring being formed of an amorphous metal material; the limitation stated in claims 16-19, 25-28, and 36-39, i.e., the size and shape of the spring; the limitation stated in claims 21, 22, 30, 31, i.e., the amorphous metal being formed of a plurality of laminated metal strips.

With respect to the limitation stated in claims 14, 23 and 34: Tadashi teaches using a amorphous spring material for a watch in order to reduce the formation of rust and the

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occurrence of breakage. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the spring material, as taught by Wiget, with the spring material, as taught by Tadashi, in order to reduce the formation of rust and the occurrence of breakage, as already suggested by Tadashi.

With respect to the limitation stated in claims 16-19, 25-28, and 36-39: the size and shape of the spring, absent any criticality, is only considered to be an obvious modification of the size and shape of the spring disclosed by Wiget as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See In re Dailey, 149 USPQ 47 (CCPA 1976).

With respect to the limitation stated in claims 21, 22, 30, 31: the amorphous metal being formed of a plurality of laminated metal strips, this limitation, absent any criticality, is only considered a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results will be obtained if the amorphous spring assembly is used to reduce the formation of rust and the occurrence of breakage, as already illustrated by Wiget and Tadashi, 2) the amorphous spring assembly, as claimed by applicant and the amorphous spring assembly used by Wiget and Tadashi are well known alternate types of amorphous spring assemblies which will perform the same function, if one is replaced with the other, of reducing the formation of rust and the occurrence of breakage, and the 3) the use of the amorphous spring assembly is considered to be nothing more than the use of one of numerous and well known alternate types of amorphous spring assemblies used to reduce the formation of rust and the

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occurrence of breakage that a person having ordinary skill in the art would have been able to provide using routine experimentation.

Response to Arguments

4. Applicant's arguments with respect to claims 14-40 and 54-57 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the spring lying in a **single plane**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claim(s). See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Jeanne-Marguerite Goodwin whose telephone number is (703) 305-0264. The examiner can normally be reached on Monday-Friday (9am-6pm), alternate Fridays off. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JMG
Nov. 18, 2002



VIT MISKA
PRIMARY PATENT EXAMINER
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